



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,577	12/30/2003	Ju-Kil Lee	21C-0106	8080
23413 7590 04/18/2007 CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER FIGUEROA, JOHN J	
			ART UNIT	PAPER NUMBER
			1712	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/18/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/748,577

Applicant(s)

LEE ET AL.

Examiner

John J. Figueroa

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. The 35 U.S.C. 112, first paragraph, rejections of record in items 3 and 4 on pages 2 and 3, respectively, of the Office Action of October 30, 2006, hereinafter 'OA', have been withdrawn in view of Applicant's arguments and amendment to claim 11 in the response filed on January 30, 2007 (hereinafter 'Response').
2. The 35 U.S.C. 102(e) rejection of claims 1-10 as anticipated by United States Patent Application Publication Number 2004/0044117 A1 to 'Keifer-Liptak', hereinafter 'Keifer-Liptak', is maintained for reasons previously made of record in item 6 on page 4 of OA and set forth below in paragraph #8.
3. The 35 U.S.C. 102(e) rejection of **claim 11 only** as anticipated by Keifer-Liptak (item 6 on page 4 of OA) has been withdrawn in view of the amendment to the claim in Response.
4. The 35 U.S.C. 103 rejection of claim 12 as unpatentable over Berghoff, Miura or Yano, in view of Keifer-Liptak (item 8 on page 6 of OA), has been withdrawn due to the cancellation of the claim in Response.

### *Allowable Subject Matter*

5. Claim 11, as currently amended, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1712

6. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or suggest the acryl-modified polyester resin having the structure and properties as recited in independent claim 1, and further having a hydroxyl value of about 1 to 20 mgKOH/g and an acid value of 15 to 30 mgKOH/g. Keifer-Liptak is the closest prior art of record and discloses an acryl polyester resin having the structure of claim 1 and a hydroxyl value of 0 to 200 mgKOH/g, but teaches that the acid value should be less than about 10 mgKOH/g.

### ***Response to Arguments***

#### **The 35 U.S.C. 112 Rejections (items 3 and 4 of OA)**

7. Applicant's arguments regarding the captioned 35 U.S.C. 112 rejections have been considered and but have become moot due to the withdrawal of these rejections in view of arguments in Response and the current amendment to claim 11.

#### **The 35 U.S.C. 102(e) Rejection over Keifer-Liptak (item 6 of OA)**

8. Applicant's arguments filed regarding the 35 U.S.C. 102(e) rejection of claims 1-10 as anticipated by Keifer-Liptak have been fully considered but deemed unpersuasive.

Applicant has amended independent claims 1 and 5 to recite the polyester resin composition to be used for coating a precoated metal steel sheet (future intended use), produced by polymerizing an intermediate in the presence of a solvent such as cyclohexanone or isophorone (product by process with respect to claim 1, drawn to a

Art Unit: 1712

composition), and further reciting physical properties for the polymer composition (i.e., Gardener bubble viscosity and pencil hardness).

Keifer-Liptak was discussed previously in item 6 of OA and all the arguments therein are incorporated herein. Keifer-Liptak further discloses that the acryl polyester composition can further comprise a solvent, such as aliphatic hydrocarbons and ketones (which encompass cyclohexanone) and that particularly suitable substrates for coating said polyester composition include, e.g., tin-plated steel, tin-free steel, and black-plated steel. (Page 3, [0023] and [0027])

Although physical properties recited in the claims for the polymer intermediate, or composition comprising thereof, may not be specifically taught in Keifer-Liptak, because the polymer/compositions disclosed in Keifer-Liptak are the same polymer/compositions encompassed by the instant claims, then both sets of polymer/compositions must inherently possess the same physical properties, such as Gardener bubble viscosity and pencil hardness.

Thus, claims 1-10, as amended, remain anticipated by Keifer-Liptak.

The 35 U.S.C. 103 Rejection (item 8 of OA)

9. Applicant's arguments filed regarding the captioned 35 U.S.C. 103(a) rejection of claim 12 have been considered but have become moot due to the withdrawal of this rejection in view of the cancellation of this claim in Response.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

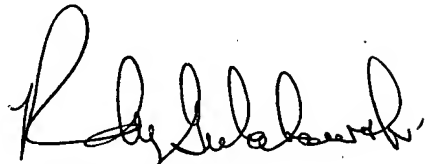
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG



RANDY GULAKOWSKI  
SUPERVISOR PATENT EXAMINER  
TECHNOLOGY CENTER 1700